

PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Title: "System and Method for Associating a Destination Document to a Source Document During a Save Process"

Appellant: Reiner Kraft

Attorney Docket No.: ARC920010034US1

Serial No.: 09/825,210

Examiner: Nathan Hillary

Filing Date: April 2, 2001

Art Unit: 2176

Board of Patent Appeals and Interferences
Commissioner for Patents
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APPEAL BRIEF

Dear Sir:

This appeal brief is submitted under 35 U.S.C. §134. This appeal is further to Appellant's Notice of Appeal that is attached hereto.

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(1) Real Party in Interest

The real party in interest is International Business Machines Corporation.

(2) Related Appeals and Interferences

No other appeals or interferences exist that relate to the present application or appeal.

(3) Status of Claims

Claims 1, 5, 6, 8-11, 15, 16, 18-22, and 24-26 are pending and remain in the application. In the Final Office Action of April 4, 2006:

- Claims 1, 5, 6, 10, 11, 15, 16, 20 - 22, and 26 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Logan (US 6,665,659 B1) in view of Heninger et al. (US 6,470,349 B1).
- Claims 8, 9, 18, 19, 24, and 25 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Logan (US 6,665,659 B1) in view of Heninger et al. (US 6,470,349 B1) and Lumsden.

(4) Status of Amendments

No amendment is currently pending.

(5) Summary of Claimed Subject Matter

The present invention relates in general to a computer software product that creates an Internet search and a retrievable activity history for a user in an Internet search session,

5.1. Problem addressed by the present invention

Prior to presenting substantive arguments in favor of the allowability of the claims on file, it might be desirable to summarize the present invention in view of the problem it addresses, in order to place the invention in its proper context. With conventional web browsers, users are able to save the target document of hyperlinks. This is accomplished by using a pointing device such as a mouse to select the hyperlink (typically using the right mouse button) then choosing the "save target as" entry to copy and save the document target to a desired location. (Page 2, lines 21 - 27).

Once a web document is saved, the Internet (or hyperlink) context from a source document to a destination document, passing by one or more intervening target documents, is lost. Consequently, the user will not be able to return from the destination document to the source document, nor would it be possible for the user to return to the download location of the document, since this information is lost during the save process. (Page 2, line 28 - page 3, line 2).

5.2. Summary of the subject matter of independent claim 1

Prior to describing the subject matter of independent claim 1, it might be useful to present the definitions, in order to help in the understanding of certain terms in claim 1:

Destination document: A final document or web page which is comprised of a target document that is bundled with contextual data about the source document. (Page 6, lines 10 - 11).

Contextual data include, for example, the input parameters 172, the destination URL 176, and the URL 174 of the source document 50. (Page 10, lines 11 - 13). The context of the source document may include, for example, one or more of the following parameters:

- The location or address, such as the URL, of the source document;
- the path, such as pages examined to navigate from the source document to the target document; and
- the input parameters required to generate the target document, such as the search query inputted by the user. (Page 3, line 29 - page 4, line 5).

Source document: An initial document or web page that points, whether directly or indirectly, to a target document and/or to a destination document. (Page 7, lines 7 - 8).

Target document: A special intermediate document or web page that points directly to a destination document. (Page 7, lines 10 - 11).

The present invention is exemplified by independent claim 1, according to which a destination document is associated to a source document during a save operation. Reference is made to system 10 (FIGS. 1 and 2) and to method 300 (FIG. 3). At step 340 of method 300 (FIG. 3), the save command prompts the system 10 and more specifically the document storage manager 150 to create the destination document 90 by bundling the target document 60 with the context data of the source document 50. (Page 12, lines 26 - 29).

More specifically, at step 305 of method 300 (FIG. 3), the user inputs query parameters 172 (FIG. 2) using the browser 140. At step 310, the document storage manager 150 sends the search query to the service provider (or server) 100. Whereupon, at step 320, the service provider 100 returns the search results to the user's web browser 140 as the source document, and establishes a connection with the system 10. The user reviews the search results at step 330, and, at step 335, the user navigates the Internet using the hyperlinks 70, 72, 74, 76 in the source document 50 and the intermediate document or documents 55 (FIG. 1). (Page 12, lines 12 - 16).

The user continues his or her navigation until he or she detects the desired target document 60 (FIG. 1). At which point, the user identifies such target document 60, issues a save command, and enters the destination address (URL) 176 of the destination documents repository 170 where he or she desires to store the destination document 90 (FIG. 1). At step 340, the save command prompts the system 10 and more specifically the document storage manager 150 to create the destination document 90 by bundling the target document 60 with the context data of the source document 50. (Page 12, lines 18 - 29; and page 1, lines 10 - 12).

As explained in the specification at page 13, lines 12 -14, the target document "White Paper" is bundled with context attributes and saved as a destination document that resides on the selected storage medium as a PDF document. Accordingly, users will be able to return to the source document, and optionally to use applications for automatically

synchronizing a destination document to the target document to reflect changes in the target document. (Page 3, lines 25 - 27; and page 4, lines 20 - 23), allowing a convenient mechanism for updating saved documents.

In other terms, the document association method of the present invention satisfies the need of conventional systems by bundling (or associating) and synchronizing a target document (i.e., a web page) and the context of a source document as metadata to intervening target documents during a save process. Accordingly, users will be able to return to the source document, and optionally to use applications for automatically synchronizing a destination document to the target document. (Page 3, lines 22 - 27).

When a user wishes to access the source document, the system uses the saved context metadata to link the user to the source document. The system is also capable of synchronizing the target document(s) to the destination document. When coupled with a synchronization application, the system allows the user to update the destination document to reflect changes in the target document(s), allowing a convenient mechanism for updating saved documents. The synchronization application performs a comparison of the destination document with the target document to detect changes and to automatically update the destination document. If the target document were deleted from its original location or relocated, the destination document is marked as orphaned. (Page 4, lines 9 - 27).

5.3. Summary of the subject matter of independent claim 11

While claim 1 exemplifies the present invention in connection with a method for associating a destination document to a source document during a save operation, claim 11 corresponds to claim 1, and exemplifies the present invention in connection with a system for associating a destination document to a source document during a save operation.

5.4. Summary of the subject matter of independent claim 20

While claim 1 exemplifies the present invention in connection with a method for associating a destination document to a source document during a save operation, claim 20 corresponds to claim 1, and exemplifies the present invention in connection with a computer program product having a plurality of instruction codes stored on a computer-readable medium, for associating a destination document to a source document during a save operation.

(6) Grounds of Rejection to be Reviewed on Appeal

Appellant respectfully traverses the following grounds of rejection and request that they be reviewed on appeal:

6.1. First Ground of Rejection

- Whether claims 1, 5, 6, 10, 11, 15, 16, 20 - 22, and 26 are obvious in view of Logan (US 6,665,659 B1) and Heninger et al. (US 6,470,349 B1).

6.2. Second Ground of Rejection

- Whether claims 8, 9, 18, 19, 24, and 25 are obvious in view of Logan (US 6,665,659 B1), Heninger et al. (US 6,470,349 B1), and Lumsden.

(7) Arguments

7.A. Argument Responding to the First Ground of Rejection

7.A.1. The Rejection

Claims 1, 5, 6, 10, 11, 15, 16, 20 - 22, and 26 stand rejected as being obvious in view of Logan (US 6,665,659 B1) and Heninger et al. (US 6,470,349 B1), hereinafter referred to as "Heninger".

Appellant respectfully submits that none of the cited references discloses all the elements and limitations of the rejected claims, or reflects the present invention as a whole. Consequently, the claims presently on file are not obvious in view of the cited references whether considered separately or in combination with each other. In support of this position, Appellant submits the following arguments:

7.A.2. Legal Standard of Obviousness

The following legal authorities set the general legal standards in support of Appellant's position of non obviousness, with emphasis added for added clarity:

- MPEP 706.02(j), "**To establish a prima facie case of obviousness, three basic criteria must be met.** First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, **the prior art reference (or references when combined) must teach or suggest all the claim limitations.** The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art and not based on Appellant's disclosure. *In re Vaeck, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991)* ... The initial burden is on the examiner to provide some **suggestion of the desirability** of doing what the inventor has done. "To support the conclusion that the claimed invention is directed to obvious subject matter, either the **references must expressly or impliedly suggest the claimed invention** or the examiner must present a convincing line of reasoning as to why the artisan would have found the claimed invention to have been obvious in light of the teachings of the references." *Ex parte Clapp, 227 USPQ 972, 973 (Bd. Pat. App. & Inter. 1985).*"
- **In determining the differences between the prior art and the claims, the question under 35 U.S.C. 103 is** not whether the differences themselves would have been obvious, but **whether the claimed invention as a whole would have been obvious.** The prior art perceived a need for mechanisms to dampen resonance, whereas the inventor eliminated the need for dampening via the one-piece gapless support structure. "Because that insight was contrary to the understandings and expectations of the art, the structure effectuating it would not have been obvious to those skilled in the art." 713 F.2d at 785, 218 USPQ at 700 (citations omitted).
- MPEP §2143.03, "All Claim Limitations Must Be Taught or Suggested: To establish prima facie obviousness of a claimed invention, **all the claim limitations must be taught or suggested by the prior art.** *In re Royka, 490 F.2d 981, 180 USPQ 580 (CCPA 1974).* "**All words in a claim must be considered** in judging the patentability of that claim against the prior art." *In re Wilson, 424 F.2d 1382, 1385, 165 USPQ 494, 496 (CCPA 1970).* If an independent claim is nonobvious under 35 U.S.C. 103, then any claim depending therefrom is nonobvious. *In re Fine, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988).*"

- MPEP §2143.01, "The Prior Art Must Suggest The Desirability Of The Claimed Invention: There are three possible sources for a motivation to combine references: the nature of the problem to be solved, the teachings of the prior art, and the knowledge of persons of ordinary skill in the art." *In re Rouffet*, 149 F.3d 1350, 1357, 47 USPQ2d 1453, 1457-58 (Fed. Cir. 1998) (**The combination of the references taught every element of the claimed invention, however without a motivation to combine, a rejection based on a prima facie case of obvious was held improper.**). The level of skill in the art cannot be relied upon to provide the suggestion to combine references. *Al-Site Corp. v. VSI Int'l Inc.*, 174 F.3d 1308, 50 USPQ2d 1161 (Fed. Cir. 1999).
- "**Obviousness cannot be established** by combining the teachings of the prior art to produce the claimed invention, **absent some teaching or suggestion** supporting the combination." *In re Fine*, 837 F.2d at 1075, 5 USPQ2d at 1598 (citing *ACS Hosp. Sys. v. Montefiore Hosp.*, 732 F.2d 1572, 1577, 221 USPQ 929, 933 (Fed. Cir. 1984)). **What a reference teaches** and whether it teaches toward or **away from the claimed invention** are questions of fact. See *Raytheon Co. v. Roper Corp.*, 724 F.2d 951, 960-61, 220 USPQ 592, 599-600 (Fed. Cir. 1983), cert. denied, 469 U.S. 835, 83 L. Ed. 2d 69, 105 S. Ct. 127 (1984). "
- "When a rejection depends on a combination of prior art references, there must be **some teaching, suggestion, or motivation** to combine the references. See *In re Geiger*, 815 F.2d 686, 688, 2 USPQ2d 1276, 1278 (Fed. Cir. 1987)." **Obviousness can only be established by combining or modifying** the teachings of the prior art to produce the claimed invention **where there is some teaching, suggestion, or motivation** to do so found either explicitly or implicitly in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See MPEP 2143.01; *In re Kotzab*, 217 F.3d 1365, 1370, 55 USPQ2d 1313, 1317 (Fed. Cir. 2000); *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988); and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992).
- "With respect to core factual findings in a determination of patentability, however, the **Board cannot simply reach conclusions based on its own understanding or experience** -- or on its assessment of what would be basic knowledge or common sense. **Rather, the Board must point to some concrete evidence in the record** in support of these findings." See *In re Zurko*, 258 F.3d 1379 (Fed. Cir. 2001).

- "We have noted that **evidence of a suggestion, teaching, or motivation to combine** may flow from the prior art references themselves, the knowledge of one of ordinary skill in the art, or, in some cases, from the nature of the problem to be solved, see Pro-Mold & Tool Co. v. Great Lakes Plastics, Inc., 75 F.3d 1568, 1573, 37 USPQ2d 1626, 1630 (Fed. Cir. 1996), Para-Ordinance Mfg. v. SGS Imports Intern., Inc., 73 F.3d 1085, 1088, 37 USPQ2d 1237, 1240 (Fed. Cir. 1995), although "the suggestion more often comes from the teachings of the pertinent references," Rouffet, 149 F.3d at 1355, 47 USPQ2d at 1456. The range of sources available, however, does not diminish the requirement for actual evidence. That is, **the showing must be clear and particular**. See, e.g., C.R. Bard, 157 F.3d at 1352, 48 USPQ2d at 1232. **Broad conclusory statements regarding the teaching of multiple references, standing alone, are not "evidence."** E.g., McElmurry v. Arkansas Power & Light Co., 995 F.2d 1576, 1578, 27 USPQ2d 1129, 1131 (Fed. Cir. 1993) ("Mere denials and conclusory statements, however, are not sufficient to establish a genuine issue of material fact."); In re Sichert, 566 F.2d 1154, 1164, 196 USPQ 209, 217 (CCPA 1977)." See In re Dembicza, 175 F.3d 994 (Fed. Cir. 1999).
- "To prevent the use of hindsight based on the invention to defeat patentability of the invention, **this court requires the examiner to show a motivation to combine the references** that create the case of obviousness. In other words, **the examiner must show reasons** that the skilled artisan, confronted with the same problems as the inventor and with no knowledge of the claimed invention, would select the elements from the cited prior art references **for combination in the manner claimed.**" See In re Rouffet, 149, F.3d 1350 (Fed. Cir. 1998).
- The mere fact that references can be combined or modified does not render the resultant combination obvious **unless the prior art also suggests the desirability of the combination.** In re Mills, 916 F.2d 680, 16 USPQ2d 1430 (Fed. Cir. 1990). Although a prior art device "may be capable of being modified to run the way the apparatus is claimed, **there must be a suggestion or motivation in the reference** to do so." 916 F.2d at 682, 16 USPQ2d at 1432.). See also In re Fritch, 972 F.2d 1260, 23 USPQ2d 1780 (Fed. Cir. 1992) (flexible landscape edging device which is conformable to a ground surface of varying slope not suggested by combination of prior art references).

- If the **proposed modification would render the prior art invention being modified unsatisfactory** for its intended purpose, then there is no suggestion or motivation to make the proposed modification. *In re Gordon, 733 F.2d 900, 221 USPQ 1125 (Fed. Cir. 1984).*

7.A.3. Application of the Obviousness Standard to the Present Invention

Logan generally describes a system for selectively distributing information from Internet resources to a user in a way that make it easier for the user to quickly identify information of particular interest. The system employs a server for generating a central library of citations, each containing metadata that describes selected information from a resource identified by a URL. The server works in conjunction with a client computer which requests information on a topic or topics of interest by supplying preference data to the server. In response, the server delivers a subset of the citations to the client computer which match the preference data from the client. The client computer places this subset of citations in a local store where they may be compared with user requests by matching the metadata in each citation to criteria specified by the user. In addition, the locally stored citations may be sorted into a particular order in response to a user request. The filtered and sorted citations may then be used to present desired information to the user, either by displaying metadata contained in the citation or by using the URL in the citation to fetch relevant information via the Internet from the original resource.

Appellant agrees with the Examiner that “Logan does not explicitly teach synchronizing.” In essence, the failure of Logan to describe such an integral element of the invention, namely: “automatically synchronizing the destination document to the target document, to reflect changes in the

target document," necessitates the finding that **Logan fails to consider the claimed invention as a whole.**

Appellant respectfully submits that **this missing element should not be dissociated from the remaining elements of claim 1.** Otherwise, the selective isolation and removal (i.e., non consideration) of an integral element of the present invention will prevent the consideration of the present invention as a whole. As stated by the foregoing legal authorities, "[i]n determining the differences between the prior art and the claims, the question under 35 U.S.C. 103 is not whether the differences themselves would have been obvious, but whether the claimed invention as a whole would have been obvious." Consequently, **the Examiner has not established a prima facie case of obviousness.**

Appellant respectfully submits that Logan describes a plurality of citations that describe selected information from the resources. This enables the user to retrieve relevant information from the original resource. The Examiner seems to analogize the citations in Logan to the destination documents of the instant claim 1.

The Examiner responds to this argument as follows: "16. In response to applicant's arguments that the citations in Logan do not qualify as "documents" (p 14, first full paragraph), it should be noted that Logan teaches that Each citation which describes a resource is preferably expressed in as a valid XML document as specified in the World Wide Web Consortium (W3C) Recommendation, Extensible Markup Language (XML)

1.0, Tim Bray, et al. W3C, Feb. 10 1998. See <http://www.w3.org/TR/REC-xml> (Column 5, lines 13 - 17)."

Appellant reiterates herein the definition of "**destination document**" as expressly recited in the present application: "Destination document: A final document or web page which is comprised of a target document that is bundled with contextual data about the source document. (Page 6, lines 10 - 11)."

In addition, Appellant submits that Logan's citations are not synchronized with target documents. In addition, Logan does not describe intermediate documents whose absence does not affect the ability to return to the source document.

Furthermore, Appellant submits that the citations in Logan do not qualify as "documents" according to the present invention. In fact, Appellant has clearly and expressly defined the destination document as: "A final document or web page which is comprised of a target document that is bundled with contextual data about the source document." Since a citation does not qualify as either a document or a web page, Logan's citations do not qualify as documents within the meaning of the present invention.

As a substitute for the admittedly missing element in Logan, the Examiner resorts to Heninger, reasoning that: "Heninger et al. do teach that in the case of caches, it is also useful to generate a source command to be placed in your target script referring back to the source script. This ensures

that the target stays synchronized with the source (Column 16, lines 16 – 20), compare with automatically synchronizing the destination document to the target document."

Appellant respectfully submits that it is unclear which documents the Examiner considers to be synchronized, since, as argued earlier, Logan's citations should not be analogized to the destination documents of the present invention, and additionally, Logan does not describe target documents that are synchronized with the destination documents. As a result, even if **Heninger** describes synchronization between documents, it still does not describe the synchronization between the target and destination documents, and thus Heninger **does not consider the present invention as a whole.**

Appellant further respectfully submits that the present invention is not limited to the step of synchronizing in abstraction, but rather in combination with the remaining elements and features of claim 1. More specifically, the present invention recites automatically synchronizing the destination document to the target document, to reflect changes in the target document. **The synchronization step, in conjunction with the bundling step, enable the present invention to track down the source document even if the intermediate documents change.** This feature is not taught in the cited references, whether considered individually or in combination with each other, and none of the references suggests such combination. As a result, the two cited references cannot be properly combined.

In response to this argument, the Examiner responds as follows: "a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. As indicated above in the rejection of claim 1, the prior art structure is capable of performing the intended use, since the prior art structure saves all the information about the document including its path using an XPATH pointer."

To the best of the Appellant's understanding of the Examiner's response, **it is not clear how the synchronization step could be regarded as an intended use of the invention.** The automatic synchronization step generates a results that is recited to explain the **operation of the claimed invention.**

Appellant wishes to clarify that "the operation of the invention" is clearly distinct from the "intended use of the invention".

Therefore based on the legal authorities above, **neither Logan, Heninger, nor the combination thereof, describes the present invention as a whole,** and consequently claim 1 is not obvious in view of these references.

7.B. Argument Responding to the First Ground of Rejection

7.B.1. The Rejection

Claims 8, 9, 18, 19, 24, and 25 stand rejected as being obvious in view of Logan, Heninger, and Lumsden.

7.B.2. Argument

Claim 1 and the claims dependent thereon are allowable, and such allowance is respectfully requested. In addition, with respect to the dependent claims, Appellant does not assert each individual feature independently in abstraction, but rather in combination with the elements and features of claim 1.

In addition, independent claims 11 and 20 are also allowable for reciting generally similar elements and limitations to those of claim 1. As a result, claims 11 and 20 and the claims dependent thereon are allowable and such allowance is respectfully requested.

Respectfully submitted,

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APPENDIX A
CLAIMS ON APPEAL

1. A method of associating a destination document to a source document during a save operation, comprising:
 - defining contextual metadata of the source document, wherein the contextual metadata includes a location of the source document;
 - identifying a target document by a content and contextual data;
 - bundling the target document, and the contextual metadata of the source document as attributes of the target document;
 - saving a bundled target document as the destination document; wherein bundling the target document comprises merging the contextual metadata of the source document and the contextual data of the target document as attributes of the target document;
 - automatically synchronizing the destination document to the target document, to reflect changes in the target document; and
 - wherein defining the contextual metadata of the source document further includes defining a navigation path from the source document to the target document, to enable a client to return to the source document from the target document, even if one or more intermediate documents along the navigation path no longer exist.

2 - 4. (Canceled)

5. The method of claim 1, wherein defining the contextual metadata of the source document includes defining the address of the source document.

6. The method of claim 5, wherein defining the address of the source document includes identifying a URL of the source document.

7. (Canceled)

8. The method of claim 5, wherein defining the contextual metadata of the source document further includes defining input parameters required to generate the target document.

9. The method of claim 8, wherein defining the input parameters includes defining an input search query.

10. The method of claim 5, wherein saving the bundled target document includes saving the destination document on a networked data repository.

11. A system for associating a destination document to a source document during a save operation, comprising:

an application that defines contextual metadata of the source document, wherein the contextual metadata includes a location of the source document;

a processor that bundles a target document identified by a content and contextual data, with the contextual metadata of the source document, as attributes of the target document;

a repository for storing a bundled target document as the destination document;

wherein the processor bundles the target document by merging the contextual metadata of the source document and the contextual data of the target document as attributes of the target document;

an application that automatically synchronizes the destination document to the target document, to reflect changes in the target document; and

wherein defining the contextual metadata of the source document further includes a navigation path from the source document to the target document, to enable a client to return to the source document from the target document, even if one or more intermediate documents along the navigation path no longer exist.

12 - 14. (Canceled)

15. The system of claim 13, wherein the contextual metadata of the source document includes the address of the source document.

16. The system of claim 15, wherein the address of the source document includes a URL of the source document.

17. (Canceled)

18. The system of claim 15, wherein the contextual metadata of the source document further includes input parameters required to generate the target document.

19. The system of claim 18, wherein the input parameters include an input search query.

20. A computer program product having a plurality of instruction codes stored on a computer-readable medium, for associating a destination document to a source document during a save operation, comprising:

 a first set of instruction codes for defining contextual metadata of the source document, wherein the contextual metadata includes a location of the source document;

 a second set of instruction codes for bundling a target document identified by a content and contextual data, with the contextual metadata of the source document, as attributes of the target document;

 a third set of instruction codes for saving a bundled target document as the destination document;

 wherein the second set of instruction codes bundles the target document by merging the contextual metadata of the source document and the contextual data of the target document as attributes of the target document;

 a fourth set of instruction codes for automatically synchronizing the destination document to the target document, to reflect changes in the target document; and

 wherein defining the contextual metadata of the source document further includes defining a navigation path from the source document to the target document, to enable a client to return to the source document from the target document, even if one or more intermediate documents along the navigation path no longer exist.

21. The computer program product of claim 20, wherein defining the contextual metadata of the source document includes defining the address of the source document.
22. The computer program product of claim 21, wherein defining the address of the source document includes identifying a URL of the source document.
23. (Canceled)
24. The computer program product of claim 21, wherein defining the contextual metadata of the source document further includes defining input parameters required to generate the target document.
25. The computer program product of claim 24, wherein defining the input parameters includes defining an input search query.
26. The computer program product of claim 21, wherein saving the bundled target document includes saving the destination document on a networked data repository.

APPENDIX B

EVIDENCE

None